

BEST AVAILABLE COPY**REMARKS**

Applicant respectfully requests entry of the RCE and the attached amendments and consideration and allowance of all of the pending claims.

Rejection of claims 1 and 4-6 as obvious over Matthews et al in view of European Patent Application 0 434 464 and Kam

The examiner maintained the rejection of claims 1 and 4-6 as obvious over Matthews et al. in view of EPA 0 434 464 and Kam.

Claims 7-21

Claims 1-6 have been canceled and claims 7-38 have been added. Claims 7-21 and (and method claims 27-33, 35 and 37-38) either directly or indirectly require "magnesium salicylate having a magnesium content of more than 500% [or higher] of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present." Support for this limitation is found at page 5, ll. 4-9. The examiner has not pointed to a teaching or suggestion of this limitation in any of the cited references.

In order to establish that the claims are *prima facie* obvious over the prior art, the examiner must point to two things in the prior art, and not in the applicant's disclosure--(1) the suggestion of the invention, and (2) the expectation of its success. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). See also MPEP 2143. The examiner has not met this burden.

The examiner admits that "Matthews et al. differ from the instant claims in not teaching the addition of magnesium salicylate." The examiner does not contend that EP 0 434 464 provides the missing teaching, but relies on Kam as teaching "overbased alkylsalicylates as additives for hydraulic fluids," citing col. 17, ll. 41-47. However, Kam teaches magnesium salts "characterized as basic hydroxy-containing alkylated aromatic carboxylic acid salts having a magnesium content of at least 150% up to 500%, preferably 200%, most preferably 250% of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present." Kam, col. 2, ll. 14-19, emphasis added.

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The examiner has not pointed to a teaching in Kam, or elsewhere, of a hydraulic fluid comprising "magnesium salicylate having a magnesium content of **more than 500%** [or higher] of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present." (Emphasis added).

Even if the examiner had pointed to such a teaching, the examiner has not pointed to any teaching or suggestion to use (a) magnesium salicylate "having a magnesium content of **more than 500%**" (b) to formulate **hydraulic fluid**. The Federal Circuit has made it clear that "a rejection cannot be predicated on the mere identification [in a single cited reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317-1318 (Fed. Cir. 2000).

In the present case, the examiner has not pointed to the claimed magnesium content in any cited reference. And, the only thing approaching examiner "findings" supporting an alleged combination is mention of a broad passing reference to hydraulic fluid in Kam:

The **carboxylic metal salts** of this invention can be effectively employed in a **variety of lubricating and fuel compositions**. The lubricating compositions include primarily crankcase lubricating oils for spark-ignited and compression-ignited internal combustion engines including automobile and truck engines, two-cycle engine lubricants, aviation piston engines, marine and railroad diesel engines and the like. In addition, however, automotive transmissions, trans-axle lubricants, gear lubricants, metal-working lubricants, **hydraulic fluids** and various other lubricating oils and greases can be improved by the incorporation therein of a small but effective amount of the carboxylic compositions of this invention

Kam, col. 17, ll. 34-47. The examiner has not made "particular findings [] as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Id.* at 1317. Even if the examiner had made the required findings, combining the teachings of Kam would not result in the combination of the current claims because the fluid would not comprise "magnesium salicylate having a

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magnesium content of **more than** 500% of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present."

The examiner cannot establish *prima facie* obviousness merely by arguing that the cited references could be modified to provide the claimed combination of features. In order to establish *prima facie* obviousness, the examiner has the burden to point to a teaching or suggestion in the **references themselves** that it would be desirable to make such a modification. MPEP 2143.01; *In re Brouwer*, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1995). The examiner has not met this burden.

Claims, as amended, are commensurate in scope with the data in the Example

In light of the foregoing amendments and argument, it is Applicant's position that Applicant does not have the burden to produce evidence of unexpected results or any other evidence of non-obviousness. Before that burden arises, the examiner has the burden to establish a case of *prima facie* obviousness. MPEP 2142. Applicant contends that the examiner has not established a case of *prima facie* obviousness of the amended claims, and that Applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142 at 2100-108.

To the extent that the examiner disagrees, Applicant submits that the data in the Example at pp. 10-11 of the specification rebuts any *prima facie* case of obviousness. The amended claims are believed to be commensurate in scope with the data in the Example, particularly when that data is read in light of the teachings at p. 5, ll. 5-9 and p. 7, ll. 7-19 of the specification.

In the final action, the examiner contended that Applicant's arguments were argued in the Appeal Brief and Reply and that the arguments were not persuasive for the reasons stated in the Examiner's Answer and the Decision of the Board of Patent Appeals and Interferences mailed March 31, 2004. Applicant submits that the claims have been amended and that new arguments have been presented in support of the amended claims. The amended composition claims 7-21 include specific amounts of magnesium salicylate and zinc dithiophosphate.

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Amended claims 13-21 also specify the compound of formula 1. The amended composition claims also specify the magnesium content of the magnesium salicylate, as discussed above. To the extent that the examiner does not agree that he has not established a case of *prima facie* obviousness, amended claims 7-21 are now believed to be commensurate in scope with the evidence of non-obviousness previously submitted. See Board opinion, p. 5.

For all of the foregoing reasons, the examiner has not established a case of *prima facie* obviousness of claims 7-21 over the cited references. Applicant respectfully requests allowance of the new claims.

Claims 22-38

Claim 22 is a method claim, which reads as follows:

22. (New) A method for reducing total weight loss during operation of equipment using hydraulic fluid, the method comprising formulating said hydraulic fluid comprising a combination of an amount of zinc dithiophosphate and a quantity of magnesium salicylate, the combination being effective to produce a first total weight loss which is less than a second total weight loss observed using a second hydraulic fluid comprising a quantity of calcium salicylate in place of said quantity of magnesium salicylate.

Neither the examiner nor the board has previously considered whether method claims 22-38 were allowable over the cited references. The examiner has not pointed to any teaching or suggestion of the claimed method in the cited references. Kam appears to teach a method for making basic metal salts which does not use acidic material to facilitate overbasing:

As the use of basic metal salts as additives for fuels and motor oils, etc., increases, it becomes important to provide improved methods for preparing these metal salts, e.g., overbased magnesium sulfonates, carboxylates and the like. For example, the basic magnesium salts presently available are prepared by utilizing a stoichiometric excess of a magnesium compound in the presence of various promoters such as alcohols, phenols and the like together with an acidic material, e.g., carbon dioxide, to promote the overbasing of the acids. Obviously, it would be an advantage to have a process for preparing these basic magnesium compositions, e.g., an overbased magnesium carboxylate which does not rely on the use of an acidic material, e.g., carbon dioxide, etc., to facilitate the overbasing. It has, for example, been found that such non-carbonated basic magnesium salts

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are particularly useful in lubricants used in railroad diesel engines and as non-gas-forming stabilizers for polymers such as polyvinylchloride.

Karn, col. 1, ll. 56-col. 2, l. 6 (emphasis added). Karn teaches a method in which "the non-carbonated, basic magnesium salts [] are formed in the absence of any substantial amount of inorganic acid material and, optionally, in the absence of any added organic acid other than (A) as defined herein." Karn, col. 2, ll. 63-67.

The examiner has not pointed to any teaching in Karn or elsewhere of a method of formulating hydraulic fluid "comprising a combination of an amount of zinc dithiophosphate and a quantity of magnesium salicylate, the combination being effective to produce a first total weight loss which is less than a second total weight loss observed using a second hydraulic fluid comprising a quantity of calcium salicylate in place of said quantity of magnesium salicylate." The examiner therefore has not pointed to a teaching or suggestion of the method of claims 22-38 in the cited references, and has not established a case of *prima facie* obviousness of new claims 22-38 over the cited references.

Dependent claims

The dependent claims include a variety of additional limitations. For example, claims 8, 25 and 26 each include a limitation to "salicylate consisting essentially of said magnesium salicylate" and claims 9-12 and 30-32 require the magnesium salicylate to have a magnesium content of either 550% or 750% of the "stoichiometrically equivalent amount of magnesium based on the amount of total acid present." Support for these limitations appear at page 5, l. 9 of the specification, and at page 10, line 32 of the specification. The examiner has not pointed to a teaching or suggestion of these additional limitations in the cited references.

For the foregoing reasons, applicant respectfully requests that the examiner allow new claims 7-38.

Rejection over Fujitsu in view of Matthews

The examiner maintained the rejection of claims 1 and 4-6 as obvious over Fujitsu in view of Matthews.

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The examiner contends that "In Tables 2 and 3 of Fujitsu et al., lubricating compositions comprising magnesium salicylate, zinc dialkyldithiophosphate, defoaming agent and pour point depressant are disclosed." However, the examiner has not pointed to a teaching or suggestion in Fujitsu or Matthews of compositions of new claims 7-21 and (or the new method claims 27-33, 35 and 37-38), which either directly or indirectly require "magnesium salicylate having a magnesium content of more than 500% [or higher] of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present." The examiner therefore has not established a case of *prima facie* obviousness of claims 7-21, 27-33, 35, and 37-38 over Fujitsu in view of Matthews.

The examiner also has not pointed to a teaching or suggestion of the method of claims 22-38 wherein a hydraulic fluid comprises "a combination of an amount of zinc dithiophosphate and a quantity of magnesium salicylate," and "the combination [is] effective to produce a first total weight loss which is less than a second total weight loss observed using a second hydraulic fluid comprising a quantity of calcium salicylate in place of said quantity of magnesium salicylate." In Table 2 and Table 3 of Fujitsu (col. 6-7) **magnesium salicylate** (metallic detergent C, Fujitsu, col. 5, ll. 54-55) **is used in combination with calcium salicylate** (metallic detergent B, Fujitsu, col. 5, ll. 51-52). In fact, the amount of calcium salicylate used (3.5 mass%, col. 6, l. 53 and col. 7, l. 22) is over twice the amount of magnesium salicylate used (1.3 mass%, col. 6, l. 54 and col. 7, l. 23). The examiner therefore has not pointed to a teaching that the combination of magnesium salicylate and zinc dithiophosphate would be effective to produce the claimed results **even in the absence of calcium salicylate**.

The examiner also has not pointed to a teaching or suggestion that would motivate a person of ordinary skill in the art to modify the references to result in the use of "magnesium salicylate having a magnesium content of more than 500% [or higher] of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present." Nor has the examiner pointed to a teaching or suggestion that would motivate a person of ordinary skill in the art to

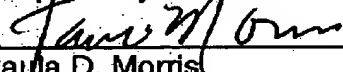
use a combination of magnesium salicylate and zinc dithiophosphate, even without using calcium salicylate, to reduce total weight loss.

For the foregoing reasons, the examiner therefore has not established a case of *prima facie* obviousness of the new claims over Fujitsu v. Matthews.

CONCLUSION

For all of the foregoing reasons, Applicant respectfully requests entry, consideration, and allowance of the new claims.

Respectfully submitted,



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